

Interview Summary	Application No.	Applicant(s)	
	10/679,246	REED ET AL	
	Examiner	Art Unit	
	Karen Cochrane Carlson, Ph.D.	1653	

All participants (applicant, applicant's representative, PTO personnel):

(1) Karen Cochrane Carlson, Ph.D.

(3) _____.

(2) Deborah L. Cadena

(4) _____.

Date of Interview: May 9 and 13, 2005.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.
If Yes, brief description: _____.

Claim(s) discussed: Claim 26.

Identification of prior art discussed: N/A.

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: KCC faxed (on May 5, 2005) a potential Examiner's Amendment (attached hereto) to the claims that would place this application in condition for allowance. DLC could not reach the inventors for approval and therefore allowance of the proposed amended claims is prevented at this time.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.



KAREN COCHRANE CARLSON, PH.D
PRIMARY EXAMINER

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiner's Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (If Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Application/Control Number: 10/679,246
Art Unit: 1653

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Page 2

This Notice of Allowability is in response to the election filed February 24, 2005 and the acceptance of the Examiner's Amendments to the Claims set forth below.

Applicant's election with traverse of Group 36, Claim 26 as drawn to SEQ ID NO: 1 in the reply filed on February 24, 2005 is acknowledged. The traversal is on the ground(s) that the oligonucleotides of Claim 9 (Group 8, drawn to antisense oligonucleotides, Claims 9-12, 22, and 28) is used in the method of Claim 26 and therefore a search of the method of Claim 29 would necessarily encompass the search of Claim 9. Additionally, Groups 37-42 should also be searched because they are all directed to Claim 26, and a search of Claim 26 would likely reveal art on these other Groups 37-42.

Applicants points have been well-taken. The Examiner advises that oligonucleotides comprising at least 15 nucleotides capable of hybridizing to SEQ ID NO: 1 are found throughout the prior art - see Telerman et al. (USP 6,503,203) who teaches their SEQ ID NO: 11 which is 99.7% identity with nucleotides 322-1274 of instant SEQ ID NO: 1 and Volario et al. (1998; DNA Seq. 9 (5-6): 307-315) who teach a nucleic acid sequence that is identical to nucleotides 213-1274 of instant SEQ ID NO: 1. Thus, it would not be advantageous to pursue the oligonucleotides drawn to SEQ ID NO: 1 as set forth in Claim 9 and 10 at this time. The remaining Claims of Group 8 are drawn to antisense nucleic acids, which have a function of preventing translation as noted on page 31 of the specification. The Examiner did not examine Claim 9 with reference to the oligonucleotides being antisense oligonucleotides, which is not required in the elected method of Group 36.

Regarding Groups 37-42, only SEQ ID NO: 1 and the encoded polypeptide of SEQ ID NO: 2 were searched by the Examiner. The Examiner is unaware that any art was found that would disclose an oligonucleotide that would identify members of the SMDP and/or SCP, except Siah-1 α , as defined on page 12 of the specification.

The requirement is still deemed proper and is therefore made FINAL.

ATTACHMENT TO Interview Summary

Art Unit: 1653

Priority is set to June 11, 1999.

An **Examiner's Amendment** to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Deborah L. Cadena on May XXX, 2005.

Examiner's Amendments to the Claims:

Cancel Claims 1-25 and 27-46.

26. (currently amended) A method for identifying nucleic acids encoding a mammalian [SMDP and/ or SCP] Siah-1 α , said method comprising:

contacting a sample containing nucleic acids with an oligonucleotide [according to claim 9] comprising nucleotides 274-321 of SEQ ID NO: 1 and wherein said oligonucleotide is no more than 500 nucleotides in length, wherein said contacting is effected under high stringency hybridization conditions of 50% formamide, 5X Denhardt's solution, 5X SSPE, 0.2% SDS at 42°C, followed by washing in 0.1X SSPE and 0.1% SDS at 65°C, and identifying [compounds] nucleic acid molecules which hybridize thereto and which complement encodes a Siah-1a protein.

47. (new) The method according to Claim 26, wherein the oligonucleotide is labeled.

48. (new) An oligonucleotide probe comprising nucleotides 274-321 of SEQ ID NO: 1 and wherein said oligonucleotide probe is no more than 500 nucleotides in length.

49. (new) The oligonucleotide probe of Claim 48, wherein said oligonucleotide probe is labeled.

Explanation of amendments: Upon restriction, oligonucleotides derived from SEQ ID NO: 1, and specifically for nucleotides 274-321 which encode the novel N-terminal amino acids of

Art Unit: 1653

Siah-1 α , would identify Siah-1 α , so the broadness of the phrase "SMDP and/ or SCP" is no longer relevant in the claim. The specified nucleotides encode the N-terminal 16 amino acids which distinguishes Siah-1 β from Siah-1 α . Limitations to 500 nucleotides can be found on page 22, para. 2, and escapes the prior art. Hybridization conditions are exemplified on page 20, para. 3, and therefore the conditions are indefinite without being specified in the claims.

Examiner's Amendments to the Specification:

At page 1, line 4, after "2000," insert --- now U.S. Patent 6,638,734, ---.

At page 7, line 13, replace "Figure 13 shows" with --- Figures 13A-13C show ---.

At page 9, line 4, replace "Figure 17 shows" with ---Figures 17A and 17B show ---.

At page 23, line 21, please delete "[http://](#)".

The following is an **Examiner's Statement of Reasons for Allowance**: The prior art of record does not teach or suggest Siah-1 α having a 16 amino acid N-terminal extension when compared to Siah-1 β , previously known in the art. Siah-1 α is a splice variant of Siah-1 β . Upon restriction, oligonucleotides derived from SEQ ID NO: 1, and specifically for nucleotides 274-321 which encode the novel N-terminal amino acids of Siah-1 α , would identify Siah-1 α , so the broadness of the phrase "SMDP and/ or SCP" is no longer relevant in the claim. The specified nucleotides encode the N-terminal 16 amino acids which distinguishes Siah-1 β from Siah-1 α . Limitations to 500 nucleotides can be found in the specification on page 22, para. 2, and escapes the prior art. Hybridization conditions are exemplified on page 20, para. 3, and therefore the conditions are indefinite without being specified in the claims. Therefore, the claims drawn to a method for finding other Siah-1 α , and oligonucleotide probes comprising nucleic acid encoding the distinguishing N-terminal amino acids, are allowable over the art of record.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the

Art Unit: 1653

issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Cochrane Carlson, Ph.D. whose telephone number is 571-272-0946. The examiner can normally be reached on 7:00 AM - 4:00 PM, off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
